

REMARKS

Regarding the status of the present application, Claims 8 and 16 have previously been canceled, Claims 1, 9, and 17 have been amended, and Claims 1-7, 9-15 and 16-19 are pending in this application. Reconsideration of this application is respectfully requested. It is respectfully submitted that the present response does not require further searching on the part of the Examiner. It is also respectfully submitted that this response places this application in condition for allowance, or in any event, places it in better condition for consideration on appeal.

Claim 19 was rejected under 35 U.S.C. § 102(b) as being anticipated by US Design Patent No. D226,526 issued to Cicero. The Examiner's rejection is not understood.

The Examiner argued that "Cicero discloses a putter head (Fig. 1) comprising: a single, solid, unitary body having a front surface with a relatively small, centrally-located, flat ball contact surface extending "substantially" the full height of the body that comprises a sweet spot of the putter head that is about 5/8 to 1/2 inches in width and lateral portions that taper rearwardly away from the ball contact surface."

As is clear from looking at Fig. 2 of the Cicero patent the ball contact area of the putter head is clearly located above the middle of the front surface of the head. The bottom one half of the front surface of the putter head is curved or rounded, progressing toward the rear of the putter head. Consequently, it is abundantly clear that the ball contact area of the Cicero putter head is no more than about 1/3 of the height of the front surface of the head. Thus, the Cicero putter head clearly does not have a flat ball contact surface extending "substantially" the full height of the body" as is recited in Claim 19. To the contrary, at least two thirds of the front surface of the Cicero putter head is not flat.

In view of the above, it is respectfully submitted that the subject matter recited in Claim 19 is not disclosed or suggested by the Cicero design patent, and certainly not without extending what is expressly shown beyond its clear scope and using hindsight reconstruction. The Cicero design patent is limited to what is specifically shown in the drawing figures, which is not a "flat ball contact surface extending substantially the full height of the body." Withdrawal of the Examiner's rejection and allowance of Claim 19 are respectfully requested.

Claim 18 was rejected under 35 U.S.C. § 103(a) as being unpatentable over US Design Patent No. D226,526 issued to Cicero. It is respectfully submitted that the arguments made above with respect to Claim 19 support the allowability of Claim 18 over the Cicero design patent. Specifically, it is respectfully submitted that the Cicero design patent does not disclose or suggest a putter having "a single, solid, unitary body having a front surface with a

relatively small, centrally-located, flat ball contact surface extending substantially the full height of the body that comprises a sweet spot of the putter head that is about 5/8 to 1/2 inches in width and lateral portions that taper rearwardly away from the ball contact surface". The Cicero patent does not disclose or suggest a putter head having a body with a "flat ball contact surface extending substantially the full height of the body" as is recited in Claim 18, and certainly not without extending what is expressly shown in the Cicero design patent using hindsight reconstruction. Therefore, withdrawal of the Examiner's rejection and allowance of Claim 18 are respectfully requested.

Claims 1-7, 9-15, and 17 were rejected under 35 U.S.C. 103(a) as being unpatentable over US Design Patent No. D282,952 issued to Mattingly in view of US Patent No. 5,769,737 issued to Holliday et al. and US Design Patent No. D234,962 issued to Swash.

The Examiner argued that "Mattingly '952 discloses a putter head comprising: a single, solid, a trapezoidal unitary body having a front surface with a relatively small, centrally-located, flat ball contact surface that extends the full height of the body and that comprises a sweet spot of the putter head and lateral portions that taper rearwardly away from the ball contact surface a base extending toward a rear end of the body." The Examiner admitted that "Mattingly does not disclose a rear portion of the putter head has a cavity" but that the Holliday et al. patent teaches this, and that "Swash '962 also teaches rear portion having a cavity to reduce the overall weight of the putter head."

It is respectfully submitted that the Mattingly design patent discloses a putter head that is solid with no cavities and actually has a raised upper surface. It is respectfully submitted that the Mattingly putter would not be modified to add a cavity as recited in Claim 1. The Mattingly putter head does not have a cavity, and there is no disclosure or suggestion in the Mattingly design patent that it would be desirable to have one. It is respectfully submitted that this rejection by the Examiner is based upon hindsight reconstruction. This will be discussed in more detail below.

It is respectfully submitted that the Mattingly design patent shows a putter head that is essentially a solid trapezoidal head with no cavities other than a hole for a shaft. The ball contact surface of the Mattingly putter head is at least, and appears to be more than, 1/3 the width of the front of the putter head, which is clearly shown in Figs. 1, 2 and 5. This is not a "relatively small" ball contact surface, it is a relatively large one. The reason that this is so is that the Mattingly putter head is designed to be used as a putter during a golf round, whereas the present invention is designed as a practice putter. The idea is to practice with a putter having a small contact area so that the stroke becomes more accurate, and then use a regular

putter with a relatively large contact surface during a golf round. This is also true of the Swash putter head.

There is clearly no disclosure or suggestion in the Mattingly design patent that a cavity would be desirable. In fact, the top surface of the Mattingly putter head is configured to have a raised triangular area that tapers parallel to respective sides of the head and a raised alignment line that extends above the main body of the head and the raised triangular area. Therefore, it is respectfully submitted that the Mattingly putter head would not be modified to add a cavity to it, particularly because this would eliminate the raised alignment line.

Consequently, notwithstanding the fact that the Holliday et al. and Swash patents disclose cavities, it is respectfully submitted that the Mattingly putter head would not be modified to include such cavities without using hindsight reconstruction. Furthermore, as was argued above, adding a cavity to the Mattingly putter head would eliminate specifically claimed features thereof and also distort the design of the Mattingly putter head.

Also, the Swash design patent discloses a putter head having upper and lower cavities (shown in Figs. 4 and 5). However, there is no flat base in the Swash putter head. The Holliday et al. patent appears to show a putter head having a cavity formed in its rear portion. However, it is clear that neither the Swash design patent nor the Holliday et al. patent discloses or suggests a putter head having a relatively small, centrally-located, flat ball contact surface that comprises a sweet spot of the putter head, or lateral portions that taper rearwardly away from the ball contact surface. Both the Swash design patent and Holliday et al. patent disclose putters that are intended for use in a round of golf, and not a practice putters.

Also, the Mattingly design patent does not disclose or suggest a putter head having a base extending toward a rear end of the body with a cavity formed behind the ball contact surface and lateral portions and above the base. There is no "base" as taught in the present application disclosed or suggested in the Mattingly design patent. The Mattingly putter head is designed such that the height of the body is more-or-less the same along the entire length of the head (except for the raised triangular area and alignment line and the back top edge of the head. It is respectfully submitted that adding a cavity to the Mattingly putter head amounts to hindsight reconstruction by distorting the express teachings of the Mattingly design patent and combining features not disclosed therein that are taught in the Holliday et al. and Swash patents using the teachings of the present application.

More specifically, the triangular portion of the top surface of the Mattingly putter head is raised above the level of the remainder of the top surface of the putter head, the

alignment line along the top center line of the head is raised above the level of the triangular portion, and the raised back edge is at the level of the alignment line. It is respectfully submitted that one skilled in the art would not eliminate these expressly disclosed features of the Mattingly design patent by adding a cavity behind the ball contact surface without using hindsight reconstruction based upon the teachings of the present invention.

The Examiner argued that "Holliday '737 teaches the large surface cavity 17 removes unnecessary weight from the club head 10 to reduce weight of the putter head (Col. 3, lines 44-50). Swash '962 also teaches rear portion having a cavity to reduce the overall weight of the putter head." It is respectfully submitted that there is no teaching or suggestion contained in the Mattingly design patent that it would be desirable to remove weight from the putter head. The design of the Mattingly putter head provides for a solid body without a cavity so that the top surface can have the alignment feature on it that extends to the back edge of the head. Adding a cavity to the Mattingly putter head would clearly eliminate this expressly disclosed feature from the Mattingly putter. It is respectfully submitted that this would not be done by one skilled in the art absent hindsight reconstruction.

It is again respectfully submitted that there is no disclosure or suggestion contained in the cited patents that would provide for their combination. This is derived using hindsight reconstruction by the Examiner, using the teachings of the cited patents in light of the teachings of the present application. Also, the Mattingly design patent teaches away from what is disclosed in the Holliday et al. patent and Swash design patent, since neither of the secondary references disclose or suggest tapered sides.

Therefore, and in view of the above, it is respectfully submitted that the Mattingly design patent, in combination with the Holliday et al. patent and Swash design patent, taken singly or together, do not disclose or suggest the putter as recited in Claim 1, and certainly not without distorting the express teachings of the Mattingly design patent and using hindsight reconstruction. Accordingly, withdrawal of the Examiner's rejection and allowance of Claim 1 are respectfully requested.

Independent Claims 9 and 17 recite substantially the same subject matter as is recited in Claim 1. Therefore, it is respectfully submitted that the subject matter recited in Claims 9 and 17 are not disclosed or suggested by the Mattingly design patent in combination with the teachings of the Holliday et al. patent and Swash design patent, taken singly or together, without the use of hindsight reconstruction. Therefore, withdrawal of the Examiner's rejection and allowance of Claims 9 and 17 are respectfully requested.

Claims 2-7 and 10-15 are considered patentable based upon the allowability of Claims 1 and 9 from which they depend. Therefore, it is respectfully submitted that the invention recited in Claims 2-7 and 10-15 are not disclosed or suggested by the Mattingly design patent, Holliday et al. patent and Swash design patent, taken singly or together, without the use of hindsight reconstruction. Accordingly, withdrawal of the Examiner's rejection and allowance of Claims 2-7 and 10-15 are respectfully requested.

The prior art heretofore made of record and not relied upon is considered pertinent to applicant's disclosure to the extent indicated by the Examiner.

In view of the above, it is respectfully submitted that all pending Claims are allowable over the art of record and that the present application is in condition for allowance.

Reconsideration and allowance of this application are earnestly solicited. It is again respectfully submitted that the present response does not require further searching by the Examiner, and places this application in condition for allowance, or in any event, places it in better condition for consideration on appeal.

Also, a change of correspondence address form was submitted with the previous response, but the latest Office Action was sent to my previous mailing address. Hopefully, this can be corrected. The new mailing address is stated below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Kenneth W. Float', with a stylized flourish at the end.

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